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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,232	07/18/2006	Stephan Schaade	2003P19290WOUS	2972

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

TRAN, QUOC DUC

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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09/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,232	Applicant(s) SCHAADE ET AL.	
	Examiner Quoc D. Tran	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 18-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Duffy et al (WO 01/06740 A2).

Consider claims 18 and 28-29, Duffy et al teach an adapter unit operatively connected to an Internet Protocol (IP) phone (see page 1 line 20-25), comprising: a channel send-receive unit that sends signaling data to an exchange of a circuit-switched telecommunications network and receives signaling data from the exchange; a data packet send-receive unit that sends data packets via a data packet transfer network towards a first telecommunication system and receives data packets from the first telecommunication system via the data packet transfer network, the data packets sent and received during a normal operating mode (see page 3 lines 1-18; Fig. 1); a data insertion-extraction unit that inserts the signaling data received by the channel send-receive unit into a data packet and forwards the packet to the data packet send unit and that extracts signaling data from a data packet received by the data packet receive unit and forwards the extracted signaling data to the channel send unit, the data inserted and extracted during the normal operating mode (see page 10 lines 1-6); and an operating mode switchover unit that switches over from the normal operating mode to an emergency operating mode if a fault occurs

on the side of the data packet transfer network, wherein the emergency operating mode ensures telecommunication via the circuit-switched telecommunications network (see page 3 lines 12-18), and wherein the signaling data is not processed by the adapter during the normal operating mode (see Fig. 8A and 8B).

Consider claim 19, Duffy et al teach the adapter unit further comprising a protocol conversion unit that converts the signal data between a circuit-switched protocol and a data-packet protocol, the conversion performed during the emergency mode (see page 10 lines 1-6).

Consider claim 20, Duffy et al teach the adapter unit further comprising a network access unit that performs network access functions for a plurality of terminals of a data packet transfer network during the emergency mode, the functions selected from the group consisting of a gatekeeper function in accordance with a protocol of the H.323 protocol family, a SIP registrar function in accordance with a SIP protocol, and SIP registrar function in accordance with a protocol based on the SIP protocol (see page 22 line 4 – page 24 line 4).

Consider claim 21, Duffy et al teach wherein the plurality of terminals are IP phones including the first IP phone, wherein the number of terminals is less than 16, and wherein during the emergency mode the signaling messages are not sent via the data packet transfer network (see page 3 lines 12-18; Fig. 6-15).

Consider claim 22, Duffy et al teach wherein at least one of the terminals is adapted to detect the fault and change to an IP address of the adapter unit or of the first IP phone (see page 21 lines 3-28).

Consider claim 23, Duffy et al teach the adapter unit further comprising a terminal unit that performs a peer-to-peer connection function during the emergency operating mode (page 3 lines 1-7).

Consider claim 24, Duffy et al teach wherein the data packets are transferred in accordance with an Internet protocol in the data packet transfer network, wherein the circuit-switched telecommunications network is a fixed network or a mobile radio network, wherein the signaling data is adapted in accordance with a signaling protocol for exchange lines between an exchange and a terminal or between the exchange and the first telecommunication system, and wherein the signaling protocol is DSS1 or based on DSS1 (page 10 lines 1-6).

Consider claim 25, Duffy et al teach wherein the fault occurs at the first telecommunication system (see page 21 lines 3-28).

Consider claim 26, Duffy et al teach wherein during the emergency operating mode: the operating mode switchover unit forwards the signaling data to a second telecommunication system that is different than the first telecommunication system used in the normal operating mode, and signaling data received from the second telecommunication system is sent to the exchange via the channel send unit (see page 22 line 1 – page 23 line 4).

Consider claim 27, Duffy et al teach wherein during the emergency operating mode: the operating mode switchover forwards the signaling data to a subscriber terminal, and the signaling data received from the subscriber terminal is sent to the exchange via the channel send unit (see page 22 line 1 – page 23 line 4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffy et al (WO 01/06740 A2).

Consider claims 30 and 38, Duffy et al teach the claimed features (see claims 18 and 28 above) except for detecting a reactivation of the data packet transfer network or of the first telecommunication system, and automatically switching over into a normal operating mode after the detection of the reactivation. However, the examiner takes an office notice that it is notoriously well known to switch back to normal operating mode after reactivate or restored. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to recognize that it is common sense the system must be placed any emergency service back into normal operating mode after repair or restored or corrected.

Consider claim 31, Duffy et al teach wherein the emergency operating mode further comprises: forwarding the signaling data from a channel receive unit of an adapter to a second telecommunication system, the second telecommunication system having performance features more restrictive than the first telecommunication system used in the normal operating mode, forwarding signaling data from the second telecommunication system to the channel send unit, and wherein the functions of the telecommunication system performed by a first IP telephone (see page 22 line 1 – page 23 line 4).

Consider claim 32, Duffy et al teach the method further comprising: detecting the failure and reactivation by a second IP telephone; and registering the second IP telephone at the second telecommunication system, wherein retaining the interface protocol in comparison with the normal operating mode is retained (see page 21 lines 3-28).

Consider claim 33, Duffy et al teach wherein the emergency operating mode further comprises: forwarding the signaling data received by the channel receive unit to an IP telephone, and forwarding signaling data sent by the IP telephone to the channel send unit, wherein the IP telephone performs functions of a telephone which is operated directly at the circuit-switched telecommunications network (see page 22 line 1 – page 23 line 4).

Consider claim 34, Duffy et al teach wherein the emergency operating mode further comprises: an IP telephone (80), which in the emergency operating mode performs functions of a telephone which is operated directly at the circuit-switched telecommunications network (20, 22), detecting the failure or the reactivation (see page 22 line 1 – page 23 line 4).

Consider claim 35, Duffy et al teach wherein the emergency operating mode further comprises: performing a protocol conversion of the signaling data into a signaling protocol for a data packet transfer network, transferring the converted signaling data to an IP telephone, receiving signaling data in accordance with a signaling protocol for a data packet transfer network from an IP telephone, and performing a protocol conversion for the received signaling data in accordance with a protocol for the signaling in the circuit-switched telecommunications network (see page 10 lines 1-6).

Consider claim 36 and 39, Duffy et al teach wherein the emergency operating mode further comprises: detecting the failure or the reactivation by an adapter, and registering at least

one IP telephone with the adapter unit or setting up a peer-to-peer connection between the adapter unit and the at least one IP telephone (page 3 lines 1-7).

Consider claim 37, Duffy et al teach wherein the signaling protocol for the data packet transfer network is a protocol of the H.323 protocol family or a SIP protocol or a peer-to-peer protocol (page 3 lines 1-7).

Consider claim 40, Duffy et al teach wherein the adapter is operatively connected less than 16 IP telephones (see page 3 lines 12-18; Fig. 6-15).

Response to Arguments

5. Applicant's arguments filed 5/23/2008 have been fully considered but they are not persuasive.

Regarding applicant arguments on page 9 that the cited reference Duffy does not disclose “the channel send-receive unit, the data insertion-extraction unit, the operating mode switchover unit and the conditions under which signaling data is processed”. Accordingly, the examiner respectfully disagrees with applicant arguments. First of all, applicant's arguments fail to comply with 37 CFR 1.111(b) and 37 CFR 1.111(c) because *they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references and because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.* Secondly, the features that the applicant indicated that Duffy is lacking are clearly disclosed in the cited reference. For instance:

Regarding the limitation “***the channel send-receive unit***” [that sends and receives signaling data to an exchange of a circuit-switched telecommunications network]. This feature is clearly met by Duffy’s gateway network 10 that sends and receives (i.e., communicates) signaling data from the PSTN 2 (see Fig. 1 and col. 3 lines 1-11).

Regarding the limitation “***the data insertion-extraction unit***” (i.e., *IP module 38, voice data from circuit-switched transfer channels coming from the connection matrix 32 is extracted and inserted into data packets which are then transferred via the Internet 12. Conversely in the IP module 38, voice data coming from the Internet 12 is extracted from data packets and switched onwards in transfer channels of the connection matrix 32*). This feature is clearly met by Duffy’s VoIP driver 14 that takes the received voice data and converted into packet data for communicates over the WAN IP network 1 (i.e., Internet) and also in reversed (converting packet data into voice data) (see page 10 lines 1-6).

Regarding the limitation “***the operating mode switchover unit and the conditions under which signaling data is processed***” [switching between normal and emergency mode if faulty condition occurs]. This feature is clearly met by Duffy’s page 3 lines 12-18 which stated "during the telephone call, [if] the quality of the telephone call falls below a predetermined quality (*i.e., faulty conditions*)... [the call is] reroute (*i.e., switchover*) to the PSTN.

Regarding applicant arguments with respect to claims 30 and 38, applicant acknowledged that the feature (“switched back to normal operating mode after reactivate or restored”) in which the examiner has taken an official notice is corrected. However, asserted that the claims include other features the examiner did not address. Accordingly, the examiner respectfully disagrees with applicant arguments. The only feature that was not addressed was the "detection of

reactivation". However, this limitation is "inherent" with respect to "switched back to normal operating mode after reactivate or restored" since the system must inherently detects that the network has been reactivated or restored prior to switched back to normal operating mode. Since the feature is "well known in the art" (as acknowledged by applicant), one of the ordinary skill would motivate to utilize such "known" teaching. Therefore, prima facie for obviousness has been established. Claim 38 contain similar features as those already addressed in claims 18 and 28 (see above rejection with respect to claims 30, 38). Therefore, it is believed that the claim has been properly addressed by the examiner.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any response to this action should be mailed to:

Application/Control Number:
10/586,232
Art Unit: 2614

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Mail Stop ____ (explanation, e.g., Amendment or After-final, etc.)
Commissioner for Patents
P.O. Box 1450
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Facsimile responses should be faxed to:

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401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Quoc Tran** whose telephone number is **(571) 272-7511**. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Curtis Kuntz**, can be reached on **(571) 272-7499**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600** whose telephone number is **(571) 272-2600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Quoc D Tran/
Primary Examiner, Art Unit 2614
September 5, 2008